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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,484	04/22/2004	William W. Shumway	HALB:052	7357
7590 10/27/2010				
Karen B. Tripp Attorney at Law P.O. Box 1301 Houston, TX 77251-1301			EXAMINER FIGUEROA, JOHN J	
			ART UNIT 1765	PAPER NUMBER
			MAIL DATE 10/27/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/829,484

**Applicant(s)**

SHUMWAY, WILLIAM W.

**Examiner**

John J. Figueroa

**Art Unit**

1765

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 May 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 16-27 and 29-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-27 and 29-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Revival from Abandonment***

1. A petition to revive this application under 37 C.F.R. 1.137(b) including the fee set forth in 37 CFR 1.17(e), was filed in this application after the abandonment of October 29, 2009, together with a response (hereinafter 'Response') to the prior Final Office Action of February 18, 2009 (hereinafter 'FOA'). Applicant's petition for revival filed on March 11, 2010 has been granted and entered. Therefore, prosecution in this application has been reopened and examination in view of the amendment to the claims filed with Response is presented herein.

### ***Response to Amendment***

2. The §35 U.S.C. 112, second paragraph, rejection of claims 1, 26, 57 and 61, and claims 2-14, 16-25, 27, 29-37 and 58-6 has been maintained for reasons previously made of record in item 5 of on page 3 of the Final Office Action dated February 18, 2009 (hereinafter 'FOA')

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 1, 26, 57 and 61, and claims 2-14, 16-25, 27, 29-37 and 58-60 that depend therefrom, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1, 26, 57 and 61 have been amended to limit the non-surfactant polymeric emulsifier to be "ethylacrylate/methylacrylic acid". There is insufficient written description support in the specification for this new limitation in the claims. Although the specification had been amended during prosecution to provide generic descriptions for certain trademarks, such as ALCOSPERSE® 747; ALCOQUEST® 747; and ALCOGUM® SL-117, there has been no evidence proffered by Applicant showing that any of these polymers are indeed known as a non-surfactant "ethylacrylate/methylacrylic acid" polymeric emulsifier as recited in the presently amended claims.

***Allowable Subject Matter***

5. Claims 1-14, 16-27, 29-37 and 57-61, would be allowable if the rejection under 35 U.S.C. 112, 1st paragraph, set forth above in this Office action is overcome in a subsequent action.

6. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not teach or suggest a method of treating or drilling a subterranean formation that comprises providing a treatment/drilling fluid composition, said composition containing a surfactant-free emulsion that includes an oleaginous fluid; a second fluid partially immiscible with the oleaginous fluid; and a non-surfactant emulsifier absorbed at the interface between said oleaginous fluid and said second fluid, wherein the non-surfactant emulsifier is an ethylacrylate/methylacrylic acid copolymer having a molecular weight of about 100,000 that further contains hydrophilic and hydrophobic moieties.

7. The closest prior art reference is Patel. Patel discloses a drilling/working fluid composition for use in a subterranean formation that includes an invert emulsion fluid composition having an oleaginous fluid (oil phase) and an oil-soluble glycol ether (aqueous phase) that can be partially miscible in oil, and an emulsifier to stabilize the invert emulsion. However, although Patel lists a series of suitable emulsifiers (e.g. VERSACOAT®) that can be used in said composition to stabilize the invert-emulsion, Patel does not teach or suggest said emulsifier to be a non-surfactant ethylacrylate/methylacrylic acid copolymer having a molecular weight of about 100,000 that further contains hydrophilic and hydrophobic moieties.

***Response to Arguments***

***The 35 U.S.C. 112 Rejection (item 5 of OA)***

8. Applicant's arguments in Response with respect to the captioned 35 U.S.C. 112 rejection have been fully considered but deemed unpersuasive.

As discussed in the prior Advisory action the evidence submitted with Applicant's response is insufficient to overcome the captioned 35 U.S.C. 112, first paragraph, new matter rejection in FOA. The abstracts provided by Applicant do not disclose the chemical composition of the specific ALCOGUM materials used in the Examples and Tables of the present specification, such as ALCOGUM L344; SL290; and SL117. Particular product specifications [or other evidence] showing the chemical structure composition of the specific aforementioned ALCOGUMs; ALCOSPERSE 747; and/or ALCOQUEST 747 to be the claimed ethylacrylate/methacrylic acid polymers are deemed necessary to overcome the new matter issues raised in the rejection. Accordingly, the response does not place the application in condition for allowance.

Thus, in the absence of substantive evidence to the contrary, the present new matter rejection has been maintained.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571)272-8916. The examiner can normally be reached on Monday-Thursday 8:00-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

//John J. Figueroa /  
Examiner, Art Unit 1765

JJF/JS